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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/054,597	04/03/1998	JOACHIM POSEGGA	2345/39	2757

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EXAMINER

ESCALANTE, OVIDIO

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/054,597

Applicant(s)

POSEGGA, JOACHIM

Examiner

Ovidio Escalante

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 29, 2002 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1,2,5,7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Moss et al. U.S. Patent 5,485,370 (hereinafter Moss).

***Regarding claim 1***, Moss discloses of an apparatus (user terminal 1,19 and network server 60) for using a service made available in a telecommunications network (Moss discloses e.g. of the service being a financial service which is made available to the user), the apparatus comprising:

at least one network server (60) having a user interface program, (col. 18 lines 33 – 41), (The network server, which is the host computer, has series of application programs for use by a terminal (telephone-computer 1 or PC terminal 19)), the user interface program being-configured to implement the service, (col. 18, lines 43-62);

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a user-side terminal (1 – Fig. 10), the user side terminal being capable of connection to the at least one network server, (Fig. 10, col. 9, lines 21-25), (The user may connect and communicate to the network server via conventional telephone lines as shown);

a control and operating device (19) executing a user interface to control and operate the service, (col. 18 lines 54 – 60), (the user terminal will operate the program (service) that was downloaded from the network server by providing instructions to the user);

wherein the control and operating device is assigned to the user-side terminal (telephone-computer) and the at least one network server transmits (downloads) the user interface program to the control and operating device before service is used, (col. 3 lines 48 – 53 and col. 12 lines 45 – 61), (the network periodically downloads new services to the terminal before the user uses the service so that the user will always have the most current service program), the user side terminal capable of being independent of the service, (col. 4, lines 15-18; col. 18, lines 6-18). Moss teaches that the home terminal includes programs that are used to control the telephone. Therefore, the terminal is also capable of being independent of the service, i.e. does not have to use the service for other operations.

**Regarding claim 2**, the user side terminal includes a telephone (1), (Fig. 1).

**Regarding claim 5**, Moss teaches of the microphone in the telephone being used for inputting speech and the control and operating device is used for displaying text, (col. 4 lines 44 – 46, 60 – 62).

**Regarding claim 7**, the control and operating device includes a computer (19), (Fig. 1).

**Regarding claim 10**, Moss discloses of a method using a service made available in a telecommunications network wherein at least one network server stores at least one user

interface program, (col. 18 lines 21 – 41), the at least one user interface program providing operating functionality, said method comprising:

using a user-side control and operating device (19) to request the at least one user interface program to be transmitted from the at least one network server to the control and operating device before the service is used, (col. 3 lines 48 – 53 and col. 12 lines 45 – 61); and

executing the user interface program by the control and operating device, so that an operator can control and operate the service through a user interface, (col. 5 lines 7 – 38),

wherein the user-side control and operating device or terminal is configured independent of the service, (col. 4, lines 15-18). Moss teaches that the home terminal includes programs that are used to control the telephone. Therefore, the terminal is also capable of being independent of the service, i.e. does not have to use the service for other operations, (col. 18, lines 6-18).

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 3-4, 6, 8-9 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss in view of Dekelbaum U.S. Patent 5,838,682.

***Regarding claims 3***, while Moss teaches of being able to provide the user with as many various services as possible, Moss does not expressly teach of the service including a speech recognition system.

Dekelbaum teaches of a system which provides Internet applications to the user. Dekelbaum further teaches of the system comprises of a speech recognition system, (col. 14 lines 38 – 40). The system receives user inputs from the user telephone and uses the user's speech for

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playback to an operator or to send to a speech recognition system to input the speech from the user onto the screen for display to an operator. All user inputs whether by DTMF or speech is sent to the operator workstation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using speech recognition in the system as taught by Dekelbaum so that the system can display speech in the form of text to the user and so that the user can verbally respond to the received service.

***Regarding claim 4***, Moss, as applied above, teaches of connecting to the network server via a conventional telephone line. Moss does not expressly teach of the apparatus comprising an ISDN line connected to the at least one network server.

Dekelbaum teaches connecting to the network server a via an ISDN connection. Dekelbaum further teaches a first channel of the ISDN line being assigned to the user side terminal and a second channel of the ISDN line being assigned to the control and operating device, (col. 6, lines 44 – 62, col. 14, lines 58 – 61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using and ISDN connection as taught by Dekelbaum so that there can be a faster connection and data speed, between the user device and network server.

***Regarding claims 6, 8, 9, 11 and 13***, Moss does not expressly teach of the control and operating device or the terminal including a JAVA processor or a JAVA execution-time environment.

Dekelbaum teaches of using JAVA in the system, (col. 12 lines 35 – 36). JAVA is used for sending to the user applets with the program.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using JAVA so that programs can be left on web pages which will allow the programs to be downloaded over the Internet.

***Regarding claim 12***, Moss, as applied to claim 11, does not expressly teach of the service providing processing of speech into text.

Dekelbaum teaches of speech-to-text conversion and the display of the text being carried out using the control and operating device and conversion of speech into text being carried out by the at least one network server, (col. 14, lines 32 – 48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using speech recognition in the system as taught by Dekelbaum so that the system can display speech in the form of text to the user.

***Regarding claim 14***, Moss does not teaches of the user interface program being transmitted as a JAVA applet or of speech to text conversions, as applied above.

Dekelbaum teaches of transmitting user programs as JAVA applets, (col. 12, lines 35 – 36). Dekelbaum further teaches of speech-to-text conversion and the display of the text being carried out using the control and operating device and conversion of speech into text being carried out by the at least one network server, (col. 14, lines 32 – 48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by providing JAVA applets so that the network server can send programs to the user through the Internet and it would have been

obvious to further modify the system by providing speech to text conversions so that the user responses via the user terminal can be displayed on a terminal screen.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moss in view of Ahlin et al. US Patent 5,321,840.

***Regarding claims 15***, Moss discloses of an apparatus (network host, user terminal) for using a service in a telecommunication network, the apparatus comprising:

means for providing at least one user interface providing an operating functionality, (col. 18, lines 49-55), (The network server provides a user interface program which is operable on the user terminal);

means for serving a network and for storing at least one user-interface, (col. 18, lines 49-55), (The network host will retrieve the user interface from the internal memory);

means for requesting transmission of the at least one user-interface to the means for requesting, before the service is used, (col. 18, lines 44-50), (When the user request a user the network host will transmit the user the requested service);

means for executing the at least one user interface so that the service is controllable and operable by the user through the at least one user interface, (col. 18, lines 54-60).

While Moss does not specifically teach of removing the user interface, Moss teaches of having a system that stores user interface programs and when a user connects to a network server the server will download a new user interface program to the user if the stored program is outdated. One skilled in the art would have known that the old user interface would have to be “removed” or replaced so that the new user interface can be used. Moss also teaches that the



system send new applications to the user so that they will not use old application, therefore, there is obviously a means to remove the old program.

Nonetheless, Ahlin which was incorporated by reference in the Moss Patent, teaches that it was well known in the art to store downloaded programs in the RAM or erasable memory so that the network server can send a signal to delete old or unused programs, (col. 9, lines 50-58; col. 11, lines 37-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by removing the user interface as taught by Ahlin so that old programs can be deleted.

7. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss in view of Ahlin and further in view of Dekelbaum.

***Regarding claims 16 and 17,*** Moss and Ahlin do not teach of the user interface program being transmitted as a JAVA applet or of speech to text conversions, as applied above.

Dekelbaum teaches of transmitting user programs as JAVA applets, (col. 12, lines 35 – 36). Dekelbaum further teaches of speech-to-text conversion and the display of the text being carried out using the control and operating device and conversion of speech into text being carried out by the at least one network server, (col. 14, lines 32 – 48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by providing JAVA applets so that the network server can send programs to the user through the Internet and it would have been obvious to further modify the system by providing speech to text conversions so that the user responses via the user terminal can be displayed on a terminal screen.

**Regarding claim 18**, Dekelbaum teaches of a system which comprises of a speech recognition system, (col. 14, lines 38 – 40). The system receives user inputs from the user telephone and uses the user's speech for playback to an operator or to send to a speech recognition system to input the speech from the user onto the screen for display to an operator.

Dekelbaum further teaches of a first channel of the ISDN line being assigned to the user side terminal and a second channel of the ISDN line being assigned to the control and operating device, (col. 6, lines 44 – 62, col. 14, lines 58 – 61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using and ISDN connection as taught by Dekelbaum so that there can be a faster connection and data speed, between the user device and network server.

**Regarding claim 19**, Moss teaches of a telephone including a microphone for inputting speech and the control and operation device including a computer to display text, (col. 18, lines 49-51). Also the Examiner notes that a telephone inherently has a microphone for inputting speech and the control and operating device displays to the user the interface program.

**Regarding claim 20**, Moss does not specifically teach of the control and operating device or the terminal including a JAVA processor or a JAVA execution-time environment.

Dekelbaum teaches of using JAVA in the system, (col. 12 lines 35 – 36). JAVA is used for sending to the user applets with the program.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using JAVA so that programs can be left on web pages which will allow the programs to be downloaded over the Internet.

***Response to Arguments***

8. Applicant's arguments filed April 09, 2001 have been fully considered but they are not persuasive.

Applicant contends that Moss does not disclose at least the limitation of the user-side terminal capable of being independent of the service since the downloaded service of Moss is dependent of the application stored by the user's computer. The Examiner respectfully disagrees.

The user's computer of Moss is a multi-purpose computer which is capable of performing other tasks and functions other than using the downloaded service. As explained above and by the Moss patent the home computer is capable of at least being configured to control and operate a telephone and/or connect to the network server. Therefore, the newly added limitation of the user-side control and operating device is configured independent of the service reads on the system of Moss since the user terminal is capable of being independent of the service by executing independent services such as controlling telephone functions.

The Examiner notes that Applicant is correct in noting that the downloaded service of Moss is dependent on what application is stored in the computer, however, the claims merely state of having the terminal independent of the service and therefore does not read away from the system of Moss.

***Conclusion***

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 872-9314, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal  
Drive, Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262.  
The examiner can normally be reached on Monday to Friday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group  
is (703) 872-9314.

Communications via Internet e-mail regarding this application, other than those under 35  
U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be  
addressed to [fan.tsang@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO  
employees do not engage in Internet communications where there exists a possibility that  
sensitive information could be identified or exchanged unless the record includes a properly  
signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly  
set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and  
Trademark on February 25, 1997 at 1195 OG 89.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ovidio Escalante  
Examiner  
Group 2645  
January 10, 2003

FAN TSANG  
SUPERVISOR & PATENT EXAMINER  
TECHNOLOGY CENTER 2600

